

REMARKS

In the Office Action dated 12/14/05, the Examiner issued a restriction requirement under 35 U.S.C. §121. In this Response, Applicant has not added nor canceled any claims. Accordingly, claims 10-21 will be pending in the application after entry of this Response.

I. Traversal of Restriction Requirement

In the Office Action, the Examiner issued a restriction requirement under 35 U.S.C. §121. Specifically, the Examiner restricted the claims to the invention of cancelled claims 1-9 and newly presented claims 10-21. The Examiner has noted that Applicant has constructively elected the invention claimed in cancelled claims 1-9 by original presentation for prosecution on the merits. The statement given by the Examiner in requiring a restriction, was that cancelled claims 1-9 were “directed to adjusting the position of a mechanical arm by viewing the target site and intervening tissue along a trajectory,” and claims 10-21 are “drawn towards tracking the first instrument towards a target site and corrective movements of the tracked instrument.” In this Response, Applicant traverses the restriction requirement and provides the following arguments in support of the traversal.

First, Applicant respectfully submits that the Examiner’s election/restriction requirement under M.P.E.P. 821.03 is improper. Section 821.03 of the M.P.E.P only applies if the Applicant elected a group of claims, subsequently canceled the elected claims and introduced new claims. In this case, Applicant submitted the new claims 10-21 in response to a first office action. These new claims are not independent or distinct from the canceled claim, namely claims 1-9. Applicant never formally elected a group of claims. As such, section 821.03 of the M.P.E.P does not apply and the election/restriction requirement is improper. Moreover, a restriction

requirement is only proper when there are two or more independent and distinct claimed inventions. *See* 37 C.F.R. 1.142. Since, the Examiner entered the amendment, thereby canceling claims 1-9 and adding claims 10-21, *only one* independent or distinct claimed invention is currently pending in the present application. As such, the restriction requirement is improper.

Second, there are two criteria that outline a proper requirement for restriction between patentably distinct inventions: (A) the inventions must be independent or distinct, and (B) there would be a serious burden on the Examiner if restriction is not required. *See M.P.E.P* 803.

With respect to the first criteria, the Examiner has not shown that the inventions of canceled claim 1-9 and claims 10-21 are independent or distinct. The Examiner merely states that cancelled claims 1-9 were “directed to adjusting the position of a mechanical arm by viewing the target site and intervening tissue along a trajectory,” and claims 10-21 are “drawn towards tracking the first instrument towards a target site and corrective movements of the tracked instrument.” Therefore, the Examiner has not shown that claims 10-21 are independent or distinct from cancelled claims 1-9.

With respect to the second criteria, the Examiner must show why there would be a serious burden on the Examiner if restriction is not required. The showing of a serious burden on the Examiner must be shown by appropriate explanation of (A) separate classification, or (B) separate status in the art, or (C) a different field of search. *See M.P.E.P* 808.02. In this case, the Examiner merely recites the claims without providing any explanation of separate classification, separate status in the art, or different field of search. Therefore, Applicant respectfully submits that the Examiner has not met her burden.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the restriction Requirement.

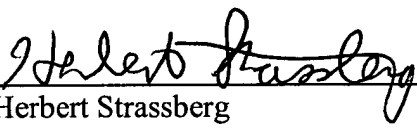
CONCLUSION

In view of the foregoing, it is submitted that all the pending claims, namely claims 10-21, are in condition for examination and allowance. Reconsideration of the rejections and objections is requested. Allowance is earnestly solicited at the earliest possible date.

Respectfully submitted,

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